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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/820,186
Filing Date: April 07, 2004
Appellant(s): MARSH ET AL.

MAILED

DEC 14 2007

GROUP 3600

Laura Kelley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on November 6, 2007 appealing from the Office action mailed May 7, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1,998,791	SCHANTZ	6-1934
2,185,161	TINNERMAN	12-1938
2,858,583	McEVOY	1-1956
3,952,455	McAlarney	4-1976
6,148,584	WILSON	11-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 2,858,583 to McEvoy et al (McEvoy).

McEvoy discloses a device comprising a base member (27 and 28) having opposite first and second faces and a cushioning projection (25) extending outwardly from the second face of the base member and covering and defining a void within the base member. The projection has a planar portion opposite the convex portion. The planar portion of the base member across the void has a thickness less than the thickness of the base member.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,4,6-11,13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 3,952,455 to McAlarney (McAlarney '455).

Regarding claims 1,13 and 14, McAlarney '455 discloses an article comprising first and second confronting components (1 and 2), wherein one of the components is a frame (1) and the other one is a movable member (2) connected to the frame and movable from an open and a closed position.

The article further comprises a device comprising a base member (20) having opposite first and second faces and a cushioning projection extending outwardly from the second face of the base member and covering and defining a void (26-29) within the base member. The base member has a planar portion extending away from the cushioning projection on opposite sides of the projection. A clip (21,23 and 25) is connected to the base member. The clip has a first member (21) connected to the base member, a second member (23) connected to the first member, and a cavity formed by the base member and the first and second members of the clip. The device is formed as a unitary member and is entirely formed of a polymeric material (Col. 3 Lines 42-62).

As to the fact that the article claimed is an article of furniture, McAlarney '455 discloses that while the device is discussed to be use on a refrigerator, it may be employed for various purposes where it has a door and a frame so as to give cushion when the door is closed (Col. 1 Lines 8-22). Therefore, the device described by McAlarney '455 is capable of being used in an article of furniture so as to provide cushioning to the door when the door is closed.

As to claim 4, McAlarney '455 illustrates that the projection has a convex portion extending outwardly from the second face of the base member and the base member has a planar portion opposite the convex portion across from the void.

As to claim 6, McAlarney '455 illustrates that the convex portion of the projection has a thickness that is less than the thickness of the base member.

As to claim 7, McAlarney '455 illustrates that the cushioning projection is elongated in a direction generally perpendicular to the thickness of the base member.

As to claim 8, McAlarney '455 illustrates that the cushioning projection is generally semi-circular.

As to claim 9, McAlarney '455 illustrates that the cushioning projection has an opening at one end (Figure 1).

As to claim 10, McAlarney '455 illustrates that the cushioning projection is closed at both ends (Figures 2-4).

McAlarney '455 fails to positively disclose that the cushioning projection has a thickness of between about .020 and about .090 inches. McAlarney '455 illustrates

that the cushioning projection is capable of having a thickness of between about .020 and about .090 inches.

Therefore, it would have being obvious to one having ordinary skill in the art at the time the invention was made to provide the cushioning projection described by McAlarney '455 with a thickness of between about .020 and about .090 inches since the change in the dimension of a prior art device is a design consideration within the skill of the art. Furthermore, the current specification fails to shows or demonstrates any showing of criticality having this dimension as the thickness of the cushioning portion.

Claims 1,4, and 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,185,161 to Tinnerman in view of US Pat No 1,998,791 to Schanz.

Regarding claim 1, Tinnerman discloses an article of furniture (Col. 1 Lines 1-7) comprising first and second confronting components (A and B), wherein one of the components is a frame (A) and the other one is a movable member (B) connected to the frame and movable from an open and a closed position.

The article further comprises a device (C) comprising a base member having opposite first and second faces and a cushioning projection (Figures 1 and 2) extending outwardly from the second face of the base member and covering and defining a void within the base member. The device is formed as a unitary member and entirely form of a polymeric material.

However, Tinnerman fails to disclose that the device further comprises a clip connected to the base member. Tinnerman discloses that the base member is attached by other means.

Schanz teaches that it is well known in the art to have a base member having a cushioning projection (14) and a clip (15) to attach the device to a surface. The device is formed as a unitary member and entirely formed of a polymeric material. Schanz further teach that the clip (15) has a first member (15) connected to a base member and a second member (16 and 16') and a cavity formed between the first and second members and the base member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device described by Tinnerman with a clip, as taught by Schanz, in order to attach and secure the device to a surface with a simple and easy to install structure.

As to claim 4, Tinnerman illustrates that the projection has a convex portion extending outwardly from the second face of the base member and the base member has a planar portion opposite the convex portion across from the void (when the convex portion is compressed).

As to claim 6, Tinnerman illustrates that the convex portion of the projection has a thickness that is less than the thickness of the base member.

As to claim 7, Tinnerman illustrates that the cushioning projection is elongated in a direction generally perpendicular to the thickness of the base member.

As to claim 8, Tinnerman illustrates that the cushioning projection is generally semi-circular.

As to claim 9, Tinnerman illustrates that the cushioning projection has an opening at one end (Figure 1).

As to claim 10, Tinnerman illustrates that the cushioning projection is closed at both ends.

As to claim 11, Tinnerman illustrates that the cushioning projection is capable of having a thickness of between about .020 and about .090 inches.

Therefore, it would have being obvious to one having ordinary skill in the art at the time the invention was made to provide the cushioning projection described by Tinnerman with a thickness of between about .020 and about .090 inches since the change in the dimension of a prior art device is a design consideration within the skill of the art. Furthermore, the current specification fails to shows or demonstrates any showing of criticality having this dimension as the thickness of the cushioning portion.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 3,952,455 to McAlarney (McAlarney '455) in view of US Pat No 2,858,583 to McEvoy et al (McEvoy).

McAlarney '455 discloses a device comprising a base member (20) having opposite first and second faces and a cushioning projection extending outwardly from the second face of the base member and covering and defining a void (26-29) within the base member. The projection has a planar portion opposite the convex portion.

However, McAlarney '455 fails to disclose that the planar portion of the base member across the void has a thickness less than the thickness of the base member.

McEvoy teaches that it is well known in the art to provide a cushioning projection (25) extending outwardly from a base member and covering and defining a void within the base member, with a planar portion of the base member across the void, opposite the convex portion, that has a thickness less than the thickness of the base member. McEvoy teaches that it could have the same thickness (Figure 2), more thickness (Figure 2a) or less thickness (Figure 2b).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the planar portion across the void of McAlarney '455 device with less thickness than the base member, as taught by McEvoy, in order to aid in the cushioning of the door when is closed with respect to a doorframe.

Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,185,161 to Tinnerman in view of US Pat No 1,998,791 to Schanz and further in view of US Pat No 6,148,584 to Wilson.

Tinnerman discloses a device (C) comprising a base member having opposite first and second faces and a cushioning projection (Figures 1 and 2) extending outwardly from the second face of the base member and covering and defining a void within the base member. The device is formed as a unitary member and entirely forms of a polymeric material.

However, Tinnerman fails to disclose that the device further comprises a clip connected to the base member. Tinnerman discloses that the base member is attached by other means.

Schanz teaches that it is well known in the art to have a base member having a cushioning projection (14) and a clip (15) to attach the device to a surface. The device is formed as a unitary member and entirely formed of a polymeric material. Schanz further teach that the clip (15) has a first member (15) connected to a base member and a second member (16 and 16') and a cavity formed between the first and second members and the base member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device described by Tinnerman with a clip, as taught by Schanz, in order to attach the device to a surface with a simple and easy to install structure.

Further, Tinnerman fails to disclose that the base member has a planar portion extending away from the cushioning projection on opposite sides of the projection. Tinnerman only discloses that the base member has a planar portion extending away from the cushioning projection on one side of the protrusion.

Wilson teaches that it is well known in the art to have a planar portion extending away from the cushioning projection on opposite sides of the projection (Figure 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cushioning portion described by Tinnerman with two planar portions at opposing sides of the projection, as taught by Wilson, since,

first, the duplication of components of a prior art device is a design consideration within the skill of the art, and second, in order to provide support for the cushioning portion. Furthermore, the current specification fails to show or demonstrate any showing of criticality having these planar portions at opposite sides of the projection.

(10) Response to Argument

The applicant argues that McAlarney fails to disclose that the clip defines a cavity that captures one of the first and second furniture components (Page 5 Argument II).

As clearly shown in Figure 1, McAlarney illustrates first and second "furniture" components (1 and 2) and a device that comprises a cushioning projection (26-29), a base (20) and a clip (21, 23 and 25).

As seen in attachment #1, the clip is comprised of a first member (21) having one end connected to the base, and a second member (23) having one end connected to the first member. A cavity is formed between the members of the clip.

The piece of furniture disclosed by McAlarney (2) is composed of a body, a shell (8), metal wall portions (13 and 14), a screw (17) and a holding part (16 and 18). As seen in attachment #1, the clip captures the edge (18) of the holding part (16). Therefore, McAlarney clearly discloses that the clip is capable of capturing one of the "furniture" components; at least a part of it since the claim language does not require capturing the whole component. Further, the claim language fails to clearly define what structure of the furniture component is captured. At the instant, McAlarney discloses that a structure (16) that is part of the "furniture" component (by means of 17) is captured in the cavity of the clip.

The applicant further argues the rejection of the claims in view of Tinnerman, as modified by Schanz. The applicant argues that Schanz fails to teach a clip having a first member with one end attached to the base and a second member with one end attached to the first member, specifically, that Schanz fails to disclose that the end of the first member is not connected to the end portion of the base (Page 7 Argument III).

Tinnerman discloses a device (C) that comprises a base member and a cushioning projection. Tinnerman uses a different method to install the device.

As seen in attachment #2, Schanz clearly illustrates a cushioning device that comprises a clip having first and second members and a base. The claim language does not define in what direction the end portions of the base are located. As seen in attachment #2, Schanz illustrates that base have end portions, viewed in the direction shown. Therefore, Schanz clearly teach that one end of the first member is connected to an end portion of the base member and the second member has an end connected to the first member other end.

Further, even if the end portions of the base member are longitudinal ends, the rejection made on the record is Tinnerman as modified by Schanz. As seen in attachment #2, Tinnerman discloses that the device is connected to the furniture at an end portion of the base. Therefore, Tinnerman, as modified by Schanz, would present the clip at a longitudinal end portion of the base in order to couple the device to the furniture component.

The applicant further argues the rejection in view of Tinnerman, as modified by Schanz and Wilson, because of the previous arguments shown in section III (Page 8 Argument IV). As state above, Tinnerman, as modified by Schanz, discloses the invention as claimed. At the instant, Wilson is only used to demonstrate that it is well known in the art to have a planar portion extending away from the cushioning projection on opposite sides of the projection.

The applicant further argues that McEvoy fails to disclose a planar portion opposite the convex portion of the cushioning projection, having a thickness that is less than the base member thickness (Page 9 Argument V).

McEvoy discloses a device comprising a base member and a cushioning projection having a planar portion opposite the convex portion. The planar portion has a thickness that is less than the thickness of the base member.

First, the limitation "opposite the convex portion" is a broad limitation that could be interpreted as being the surface directly on the projection or the surface across the void that is part of the projection. McEvoy device shows both interpretations.

The first interpretation would be if the planar surface is directly opposite the convex portion. One having ordinary skill in the art could appreciate that the projection described by McEvoy is comprised of multiple planar portions, as shown in attachment #3, each opposite the convex portion.

The second interpretation would be if the surface is across the void that is part of the projection. As seen in attachment #3, McEvoy also illustrates this interpretation, having planar surfaces opposite the convex portion, across the void. Further, these

surfaces have a thickness that is less than the thickness of the base (a portion of the surface). The claim language does not require that the whole thickness of the planar surface have to be less than the thickness of the base.

The applicant finally argues that McAlarney, as modified by McEvoy, fails to disclose the invention claimed (Page 9 Argument VI), specifically because McEvoy fails to disclose the planar surface claimed. As stated above, McEvoy clearly disclose the planar surface limitation. One having ordinary skill in the art would appreciate that by adding this teaching into McAlarney device would aid in the cushioning of the door when is closed with respect to a doorframe or would present a device that can be made with less material.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

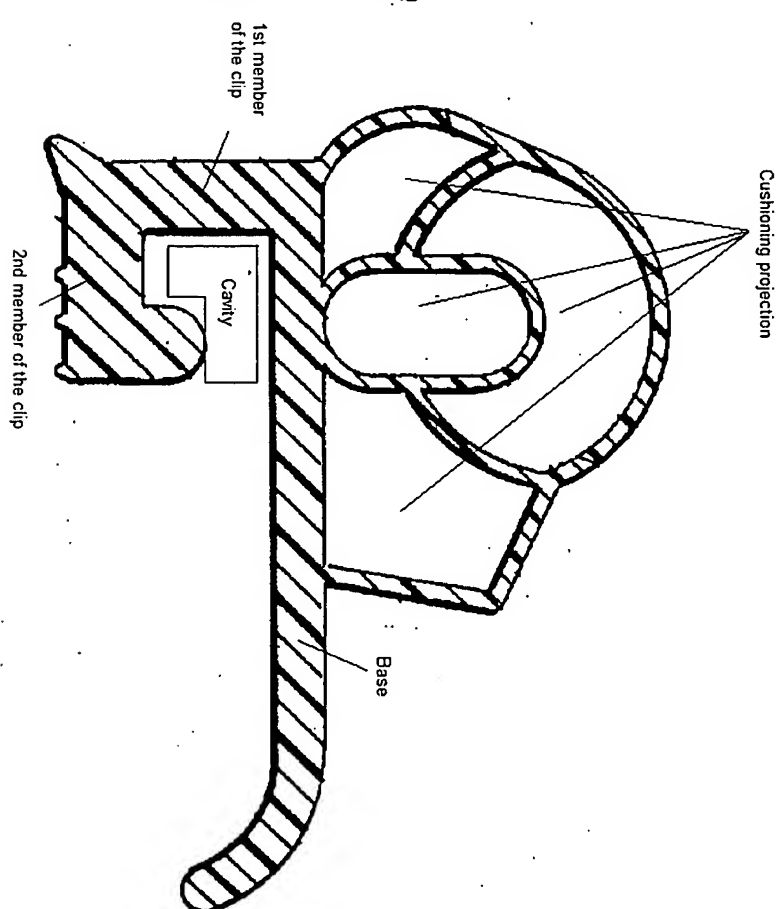
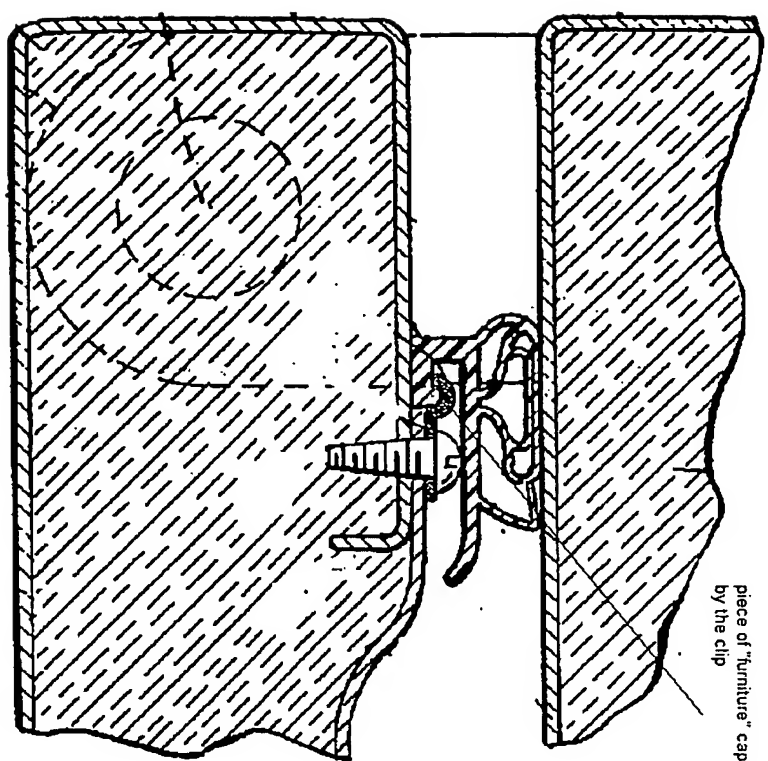
Respectfully submitted,

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Attachment #1

